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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: Mersch, Gerhard

Serial No.: 09/931,489

Filed: 08/21/2001

Group Art Unit: 3634

Examiner: Redman, Jerry E.

For: DOOR MODULE FOR MOTOR VEHICLE DOORS

Official

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9/20/02

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GROUP 3600

RESPONSECommissioner of Patents and Trademarks  
Washington, D.C. 20231

Dear Sir:

This paper is responsive to the Office Action mailed on June 20, 2002.

Applicant thanks the Examiner for the remarks and analysis contained in the Office Action. Claims 7-21 are still pending in this application. Applicant respectfully requests reconsideration of this application.

Claims 7-21 were rejected under 35 U.S.C. §103 as being unpatentable over *Seeberger, et al.* in view of *Yamashita*. Applicant respectfully traverses the rejection. There is no *prima facie* case of obviousness because there is no motivation to make the proposed combination.

*Seeberger, et al.* teach an arrangement having a drive and control unit 9 mounted on the "dry space side" of the support plate 3. The drive control unit includes switches 92, 93 that are used by an individual within the vehicle (i.e., on the other side of the lining 5A) for controlling the position of a window, for example. The switches 92 and 93 extend through openings 93A in the lining 5A.

There would be no motivation to include a cover like that shown in *Yamashita* with the arrangement of *Seeberger, et al.* First, there is no benefit to adding such a

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cover because the drive and control unit 9 is already mounted on the "dry space side" of the support plate 3. Further, if a cover as taught by *Yamashita* were included in the *Seeberger, et al.* reference, the switches 92 and 93 would no longer be able to protrude through the openings 93A and, therefore, their intended function would be defeated.

A proposed combination of references does not establish a *prima facie* case of obviousness without a legally sufficient motivation to make the proposed combination. Where a proposed combination defeats an intended purpose or function of the teachings of a primary reference or where there is no benefit to making the combination, there is no motivation. In this case there are at least two reasons why there is no *prima facie* case of obviousness. The claims cannot be considered obvious.

Further, even if the proposed combination were proper, the result is not the same as the claimed arrangement.

Applicant respectfully submits that this case is in condition for allowance. If the Examiner believes that a telephone conference will facilitate moving this case forward to being issued, Applicant's representative can be contacted at the telephone number indicated below.

Respectfully submitted,

CARLSON, GASKEY & OLDS

By: 

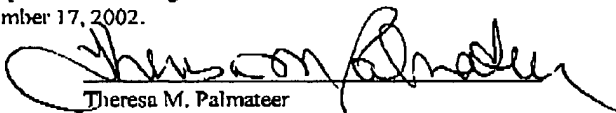
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Dated: September 17, 2002

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**CERTIFICATE OF FACSIMILE**

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 872-9326) on September 17, 2002.

  
Theresa M. Palmateer

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